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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,247	12/15/2003	Sebastien Joly	20513-00599-US	2280

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EXAMINER
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PALABRICA, RICARDO J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/734,247

Applicant(s)

JOLY ET AL.

Examiner

Rick Palabrica

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/15/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's election without traverse of Group II (apparatus) in the reply filed on 2/14/05 is acknowledged.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites in the wherein clause a limitation of the claimed device, i.e., length of the tubular body of the gripper, that is defined in terms of unknowns, i.e., attributes of the guide tube. Note that the preamble recites the guide tube as part of an intended use clause, and this tube is not the same for all reactors. Thus, the claim defines an unknown in terms of another unknown.

Claim 6 recites the limitation "the bearing piece" in line 2. There is insufficient antecedent basis for this limitation in the claim. (Examiner's note: Correcting the objection to this claim, as discussed in section 3 below will overcome this rejection).

#### ***Claim Objections***

3. Claim 6 is objected to because it is incorrectly recited as being dependent from claim 3 that does not provide a proper antecedent for the limitation, "the bearing piece." The proper dependency is to claim 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by anyone of Shukei (U.S. 3,768,668) or Cooper (U.S. 4,377,956) or Ross (U.S. 5,127,145).

Shukei discloses a control element assembly handling mechanism (e.g., see Figs. 2 and 3). Applicant's claim language reads on Shukei's apparatus as follows: a) "tubular body" reads on shield 76; b) "two opposed arms" reads on fingers 70; c) "control member" reads on plunger 66; d) "bearing piece" reads on the combination of top plate 46 and side wall 42'; e) "load limiting spring" reads on spring 68.

Cooper discloses a pipe-lifting tool (e.g. Fig. 1). Applicant's claim language reads on Cooper's apparatus as follows: a) "tubular body" reads on hollow body or shank 12; b) "two opposed arms" reads on cam members 13; c) "control member" reads on push rod; d) "bearing piece" reads on element 16; e) "washer reads on bushing 52.

Ross discloses a tool for repair of fluidic equipment (see Fig. 1). Applicant's claim language reads on Ross' device as follows: a) "tubular body" reads on hollow shaft 2; b) "two opposed arms" reads on levers 4; c) "control member reads on shaft 6; d) "bearing piece" reads on element 11; "load limiting spring" reads on spring 8.

The claims are replete with statements that are either essentially method limitations or statements of intended or desired use. For example, "for handling a guide

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tube ...", "for controlling the said arms", "for bearing against the upper end of the upper tube", "first of all, deploys the arms then brings these arms to the bearing piece," , etc.

These clauses, as well as other statements of intended use do not serve to patently distinguish the claimed structure over that of the reference, as long as the structure of the cited references is capable of performing the intended use. See MPEP 2111-2115.

See also MPEP 2114 that states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531.

[A]pparatus claims cover what a device is, not what a device does."  
Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525,1528.

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Any one of the systems in the cited references is capable of being used in the same manner and for the intended or desired use as the claimed invention.

5. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Cooper. As to the claim limitation regarding the elasticity of the washer, any metal has some elastic property. Absent a definition of the degree of elasticity of the claimed washer, Cooper's bushing reads on the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shukei in view of Suvanto et al. (3,856,621). Shukei discloses the Applicant's claims except for the screw and nut system for the control member. Shukei discloses his control member 66 being moved by means of a hydraulic cylinder 58(see col. 3, lines 2+).

Suvanto et al. teach a lifting mechanism for core components (see Fig. 11a and b). They show a control member 73 connected to two opposed arms 70 for lifting a fuel assembly, with the control member being operated by means of a compressed air cylinder 74. Suvanto et al. teach that instead of a compressed air cylinder, a hydraulic cylinder, an electromagnet or a screw and nut may be used (see col. 4, lines 12+).

This teaching shows that Applicant's screw and nut system is old art, and the selection of the means for operating a control member of a lifting mechanism, such as those in Shukei and Suvanto, is matter of design choice.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus, as disclosed by Shukei, by the teaching of Suvanto et al., to use a screw and nut system instead of a hydraulic cylinder for operating the control member, because such modification is no more than the substitution of one control expedient by another well-known expedient.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References D and E further illustrate prior art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 703-306-5756. The examiner can normally be reached on 6:30-5:00, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Carone can be reached on 703-306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJP  
February 24, 2005

*R Palabrica*